

REMARKS/ARGUMENTS

1. The Examiner rejected claims 1, 2 and 8-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,382,639 issued to Smith et al. (the “Smith Patent”). Claims 5 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,134,250 issued to Caveney et al. (the “Caveney Patent”). Claims 13-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,442,885 issued to Laven et al. (the “Laven Patent”). Claim 16 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,660,119 issued to Perkins (the “Perkins Patent”). Claims 3, 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Smith Patent in view of U.S. Patent No. 6,385,941 issued to Power Jr. et al. (the “Power Patent”). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Caveney Patent in view of the Power Patent. Claims 5-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claim 4 was objected to as being dependent upon a rejected base claim, but the Examiner indicated that such claim would be allowable if rewritten in independent form. The specification was objected to for failing to provide proper antecedent basis for the terms “plurality of inner walls” and “elongated projections” as recited in claim 1. Claim 9 was objected to because it appears to be repeated language that was previously recited in line 3 of claim 8. Finally, the present Office Action was made final even though original claim 16 was only properly rejected in the first instance in the present Office Action. Withdrawal of the “final” status of the present Office Action and reconsideration of the instant application are respectfully requested in view of the amendments and/or remarks provided herein.

Objections to the Specification

2. The specification was objected to for failing to provide proper antecedent basis for the claimed subject matter. In particular, the Examiner states that there is no support in the specification for the terms “plurality of inner walls” and “elongated projections” as recited in claim 1. Applicants have herein amended claim 1 to remove the problematic terms and replace them with the terms “interior surface” and “elongated rails.” Applicants’ new terminology is supported on at least page 6, line 27 and page 7, line 14 of Applicants’ originally filed

specification. Accordingly, Applicants have overcome the Examiner's objection and respectfully requests that the Examiner withdraw her objection to the specification.

Objection to the Claims

3. Claim 9 was objected to because it appears to be repeated language that was previously claimed in line 3 of claim 8. Applicants have herein canceled claim 9. Therefore, Applicants respectfully request that the Examiner withdraw her objection to the claims.

Rejection under 35 U.S.C. § 112, second paragraph

4. Claims 5-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that the term "said outer walls" recited in line 3 of claim 5 lacks sufficient antecedent basis in the claim. Applicants have herein amended claim 5 to remove the problematic terminology. Therefore, Applicants respectfully request that the Examiner withdraw her rejection of claims 5-7 under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 102(b)

5. Claims 1, 2, and 8-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Smith Patent. In particular, with respect to claims 1 and 2, the Examiner asserts that the Smith Patent discloses a structural beam that includes an elongated member (B, C) having a wall with elongated rails or projections (19) disposed centrally on the wall. The Examiner also asserts that the Smith Patent discloses a reinforcing slat (21) that is connected to the rails (19). With respect to claims 8-10, the Examiner asserts that the reinforcing slat or insert (21) defines a channel and comes into inter-fitting relation with the rail (19).

Applicants have herein amended independent claims 1 and 8 to more clearly distinguish said claims from the disclosure of the Smith Patent. In particular, Applicants have amended claims 1 and 8 to recite a reinforcement slat or insert, as applicable, which defines a plurality of channels that receive the plurality of rails when the slat/insert is connected to the rails. Such a reinforcement slat and resulting structural member is not disclosed or suggested by the Smith Patent.

As depicted in FIG. 2 of the Smith Patent, the rails (19) together define a single channel into which the slat/insert (21) is inserted to provide support. The slat/insert (21) also defines a channel having a geometry similar to the geometry of the channel defined by the rails (19); however, the channel defined by the slat/insert (21) does not receive anything.

By contrast, amended claim 1 recites a structural beam member that includes (a) a plurality of rails connected to a central portion of a wall of a load bearing element and (b) a reinforcement slat defining a plurality of channels that receive the plurality of rails. In other words, in claim 1, the reinforcement slat defines channels that receive the rails. As discussed above, the slat (21) disclosed in the Smith Patent defines a single channel that does not receive anything. Rather, in the Smith Patent, the rails (19) define a channel that receives the slat (21). As a result, the Smith Patent clearly fails to disclose or suggest the limitations of claim 1.

Claim 8 similarly recites a support member that includes (a) a plurality of rails connected to a central region of a wall of a beam and (b) a reinforcing insert defining a plurality of channels that receive the plurality of rails. As a result, the insert (21) and rails (19) disclosed in the Smith Patent are not identical or similar to the insert and rails recited in claim 8 because the insert (21) disclosed in the Smith Patent does not define channels that receive the rails. Rather, as disclosed in the Smith Patent, the rails (19) define a single channel that receives the insert (21).

Therefore, based on the foregoing, the Smith Patent fails to disclose or suggest the recitations of independent claims 1 and 8, as amended. Accordingly, Applicants respectfully request that the Examiner pass claims 1 and 8 to allowance.

Claims 2 and 9-10 depend upon claims 1 and 8, respectively, which claims have been shown allowable above. Therefore, since claims 2 and 9-10 each introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicants respectfully submit that claims 2 and 9-10 are in proper condition for allowance.

6. Claims 5 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Caveney Patent. In particular, the Examiner asserts that the Caveney Patent discloses a structural member (11) that includes an elongated element (12) having a plurality of walls, wherein an outer surface of a wall defines an anchoring member (18), and a reinforcement slat defining a female receptor formed by arms (21, 22) of the slat.

Applicants have herein amended independent claim 5 to more clearly distinguish said claim from the disclosure of the Caveney Patent. In particular, Applicants have amended claim 5 to recite a structural member that includes (a) a plurality of rails connected to a central portion of an outer surface of one of the walls of an elongated element and (b) a reinforcement slat defining a plurality of channels that receive the rails when the slat is connected to the rails. The Caveney Patent fails to disclose or suggest a structural member having such a construction.

The Caveney Patent discloses a structural member (11) having walls that terminate in male connectors (18) and a cover (13) having side walls that terminate in female connectors defined by two arms (21, 22) and two latching surfaces (24). None of the walls of the structural member (11) disclosed in the Caveney Patent include rails that are centrally connected to an outer or exterior surface of the wall. In addition, the Caveney Patent fails to disclose a slat that includes channels to receive the centrally positioned rails. Rather, the Caveney Patent expressly discloses a cover (13) (*see col. 2, line 25*), not a slat.

Therefore, the Caveney Patent wholly fails to disclose or suggest the recitations of claim 5. Accordingly, Applicants respectfully request that the Examiner pass claim 5 to allowance.

Claim 6 depends upon claim 5, which claim has been shown allowable above. Therefore, since claim 6 introduces additional subject matter that, when considered in the context of the recitations of claim 5, constitutes patentable subject matter, Applicants respectfully submit that claim 6 is in proper condition for allowance.

7. Claims 13-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Laven Patent. In particular, the Examiner asserts that the Laven Patent discloses a method of reinforcing a support member comprising the steps of (a) providing a beam (12) having a plurality of walls (16, 20, 24), wherein two of the walls have projecting lugs (28), (b) providing a reinforcing insert (1) defining recesses (5) to mate in inter-fitting engagement with the lugs (28), and (c) connecting the insert to the beam by inter-fitting the lugs (28) within the recesses (5).

Applicants have herein amended independent claim 13 to more clearly distinguish said claim from the disclosure of the Laven Patent. In particular, Applicants have amended claim 13 to recite a method of reinforcing a support member comprising steps of providing a beam having a plurality of walls, wherein at least one of the walls has a plurality of elongated rails; providing a reinforcing insert defining a plurality of elongated channels adapted to mate in inter-fitting

engagement with the rails; and connecting the insert to the beam by inter-fitting the rails of the beam within the channels of the insert. The Laven Patent fails to disclose or suggest such a method for reinforcing a support member.

The Laven Patent discloses a box frame fabricated by inserting a first C-shaped member (1) into a second, complementary C-shaped member (12) such that T-shaped projections emanating from the inner surfaces of the top and bottom walls of the first member (1) lock into matching T-shaped recesses (5) in the outer surfaces of the top and bottom walls of the second member (12). Based on its disclosure, the Laven Patent clearly fails to disclose or suggest a method for reinforcing a support member in which elongated rails centrally connected to an inside surface of a wall of a beam are inserted or inter-fitted into corresponding elongated channels of a reinforcing insert as is recited in amended claim 13. In other words, the Laven Patent fails to disclose or suggest a structure in which centrally positioned, elongated beam rails are inter-fitted into corresponding elongated insert channels when the insert is connected to the beam.

Therefore, based on the foregoing, the Laven Patent fails to disclose or suggest the recitations of independent claim 13, as amended. Accordingly, Applicants respectfully request that the Examiner pass claim 13 to allowance.

Claims 14 and 15 depend upon claim 13, which claim has been shown allowable above. Therefore, since claims 14 and 15 each introduce additional subject matter that, when considered in the context of the recitations of claim 13, constitutes patentable subject matter, Applicants respectfully submit that claims 14 and 15 are in proper condition for allowance.

8. Claim 16 was rejected under 35 U.S.C. § 102(b) as being anticipated by the Perkins Patent. In particular, the Examiner asserts that the Perkins Patent discloses the use of a rectangular strut (16) having four walls (22, 40, 44) that meet at corner intersections and define a space, wherein a transverse web (24) extends from one corner to a diagonally opposing corner. Applicants traverse the Examiner's rejection, but have amended claim 16 to clarify the intended application of the extruded bracing member recited in such claim. In particular, Applicants have amended claim 16 to recite an extruded bracing member for use in forming an architectural structure. The Perkins Patent provides no comparable disclosure or suggestion.

The Perkins Patent discloses a lightweight structural beam constructed of cardboard and used to form a pallet. The beam is formed by folding the cardboard along pre-scored fold lines in a first direction and then in a second direction using a rolling action. *See Abstract*, lines 1-9. The Perkins Patent fails to disclose or suggest that the beam, or any portion thereof, is extruded. Moreover, by disclosing only a cardboard beam, the Perkins Patent expressly teaches away from the use of extruded bracing members or beams because, to the best of Applicants' knowledge, an extrusion process cannot be used to form a cardboard beam.

By contrast, original claim 16 expressly recites an "extruded" bracing member. Applicants have voluntarily amended the claim to clarify that the intended use of such member is to form a frame for an architectural structure, but such amendment is not necessary to distinguish the recitations of claim 16 from the disclosure and suggestion of the Perkins Patent. Nevertheless, the use clarification does further distinguish the beam disclosed in the Perkins Patent from the bracing member recited in claim 16 because the beam disclosed in the Perkins Patent is clearly used to form a pallet upon which items are stacked.

Therefore, based on the foregoing, the Perkins Patent fails to disclose or suggest the recitations of independent claim 16. Accordingly, Applicants respectfully request that the Examiner pass claim 16 to allowance.

Rejections under 35 U.S.C. § 103(a)

9. Claims 3, 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Smith Patent in view of the Power Patent. Claims 3 and 11-12 depend upon claims 1 and 8, respectively, which claims have been shown allowable above. Therefore, since claims 3 and 11-12 each introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicants respectfully submit that claims 3 and 11-12 are in proper condition for allowance.

10. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Caveney Patent in view of the Power Patent. Claim 7 depends upon claim 5, which claim has been shown allowable above. Therefore, since claim 7 introduces additional subject matter that, when considered in the context of the recitations of claim 5, constitutes patentable subject matter, Applicants respectfully submit that claim 7 is in proper condition for allowance.

Allowable Subject Matter

11. Claim 4 was objected to as being dependent upon a rejected base claim, but the Examiner indicated that such claim would be allowable if rewritten in independent form. Applicants would like to thank the Examiner for indicating the allowability of claim 4 if re-written in independent form. However, for the reasons set forth above, Applicants also believe that claims 1-8, 10-16 and new claims 17-19 are allowable over the prior art of record. Accordingly, Applicants respectfully request that the Examiner issue a notice of allowance allowing all 18 pending claims of the present application.

Other Amendments to the Claims

12. Applicant has herein amended several of the claims to correct minor informalities therein, to broaden the claims in certain respects, to clarify certain aspects of the claims, and to make the text of dependent claims consistent with the amendments made to their respective base claims. None of these amendments were intended to narrow the claims in any manner or were made for any purpose related to patentability. Applicants submit that all such claim amendments are fully supported by Applicants' originally filed specification.

New Claims

13. Applicants have herein added new claims 17-19 directed to additional features of the present invention. Applicants submit that such claims are fully supported by Applicants' originally filed specification and are patentably distinct from the prior art of record. Accordingly, Applicants request that the Examiner pass new claims 17-19 to allowance. With the addition of claims 17-19 and the cancellation of claim 9, eighteen claims remain pending in the present application, five of which are independent. Applicants have previously paid for examination of twenty claims, five of which could be independent; therefore, no additional fees are due for examination of new claims 17-19.

Request to Withdraw Final Nature of Current Office Action

14. Applicants respectfully request that the Examiner withdraw the "final" status of the present Office Action. In the prior Office Action dated February 12, 2003 ("Prior Office

Action”), claim 16 was listed as rejected in the document entitled “Office Action Summary,” but the basis for such rejection was never specified in the body of the Office Action. Since the Examiner failed to specify the basis for rejecting claim 16 in the Prior Office Action, such rejection was improper and cannot form the basis upon which to subsequently issue a Final Office Action.

Section 707.07(d) of the Manual of Patent Examining Procedure (M.P.E.P.) provides in relevant part:

Where a claim is refused for any reason relating to the merits thereof it should be “rejected” and the ground of rejection fully and clearly stated, and the word “reject” must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection.

[Emphasis added.] Further, Section 706.07(a) of the M.P.E.P. provides in relevant part:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement...

In the instant case, the Examiner has not previously provided “full and clear” grounds or even a “statutory basis” for the rejection of original claim 16 as required by M.P.E.P. § 707.07(d), nor have Applicants ever previously amended that claim. Thus, the Examiner’s rejection of original claim 16 in the present Office Action sets forth the first basis for rejection of that claim. As a result, the present rejection of claim 16 could not have been “necessitated by applicant’s amendment” because no such amendment had been made. Therefore, Applicants respectfully request that the Examiner withdraw the finality of the present Office Action because the present Office Action is the first Office Action to provide a rejection of original claim 16 specifying the grounds for such rejection in compliance with M.P.E.P. § 707.07(d).

15. The Examiner is invited to contact the undersigned by telephone, facsimile, or email if the Examiner believes that such a communication would advance the prosecution of the instant application. Please charge any necessary fees associated herewith, including extension of time fees (if applicable and not paid by separate check), to the undersigned’s Deposit Account No. 50-1111.

Respectfully submitted,

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